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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,218	08/19/1999	JEFFRY JOVAN PHILYAW	PHLY-24.706	8858

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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/378,218

Applicant(s)

PHILYAW ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.

Request for Continued Examination

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/2003 has been entered.
3. Amendment C, Paper #8, received 5/12/2003, has been entered into record.
4. Claims 1-19 are now pending.

Priority

5. This application is a continuation-in-part (CIP) of application number 09/151,530, filed 9/11/1998, now U.S. Patent Number 6,098,106. Presently claimed subject matter directly supported in this patented document is entitled to this effective priority filing date. All new subject matter set forth in the claims (and specification) is not so entitled.
6. The claimed invention set forth in this application (entire combination of independent limitations) will be treated with an effective filing date of 8/19/1999.

Drawings

7. The Examiner contends that the drawings submitted on 1/29/2001 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 2 recites "the remote location" in line 3 of the claim. There is lack of antecedent basis for this limitation in the claim. This deficiency is a direct result of Applicant's current amendments. Applicant is required to remedy this, and potentially other, antecedent basis deficiencies, as a result of changing limitation(s) in the independent claim(s).

11. Further, the limitation "the user location" is recited in all of the claims, for instance, Claim 1, Lines 14, 16, and 17, and Claim 2, Lines 16 and 18. The multiple uses of this descriptive limitation is not consistent, ranging from the computer at the user location, to identification value(s) identifying the user location. It will be assumed the functionality described in these claims (i.e., transmitting, receiving, processing, etc.) occurs with "a computer at the user location", as specifically detailed in claim 1, rather than the "location", itself, except where this limitation is directly used to describe information related to the computer at the user location, namely, inter alia, claim 3. The "user information" recited and parallel to the usage exhibited in claim 3 will be interpreted to relate to "information relating to the computer or computer user at the user location."

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12. Claims 1-19 have been amended to recite limitation(s) including the word "perceivable" in the independent claims relating to the "unique code(s)" embedded within an audio and/or video digital signal. It is unclear what this code is "perceivable" to; that is, an embedded URL within an audio signal (as well known in the prior art) would have been inherently "perceived" (e.g., by the receiving terminal) in order to effect functionality. The term "perceived" infers human interpretation, yet the claim remains broad enough to interpret the "extracting" of an embedded "unique perceivable code" by both people and/or terminals. In fact, the breadth of this functionality does not preclude a viewer and the use of a computer operated by this viewer to retrieve information about a specific product using a typical Internet address or URL supplied directly from retailer(s) during television commercials. These images/text/address/etc., or other "unique perceivable codes" are inherently embedded within the audio/video, clearly "perceivable" as part of the picture/sound, routinely "extracted" during rendering of the audio/video by the user (or terminal as detailed in the following rejections), and results in the retrieval of information from the vendor, as claimed.

13. Lastly, Applicant has had multiple opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP § 2111. Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. Additionally, Applicant has not argued any narrower interpretation of the claim

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language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. The Examiner notes that Applicant employs terminology which has broad meaning in the art and thus requires a broad interpretation of the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intend broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to clearly, distinctly, and uniquely claim the invention. The current claims infer coverage breadth which is inconsistent with breadth of the disclosure and are not found distinguishable above the prior art of record.

Claim Rejections - 35 USC 103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

16. Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Portuesi (U.S. Patent Number 5,774,666), hereinafter referred to as Portuesi, in view of Sherman (U.S. Patent Number 5,213,337), hereinafter referred to as Sherman, in view of Hudetz et al. (U.S. Patent Number 5,978,773), further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

17. Portuesi disclosed the embedding of URL information in a multimedia presentation, i.e., video with audio. See, inter alia, Column 2, Lines 22-38. The multimedia information was fully capable of being recorded and played back later, e.g., from a computer file, CD, or DVD. See, inter alia, Column 3, Lines 22-29. Further, referenced data was presented during rendering of the digitally stored multimedia information. See Column 2, Lines 39-59. Additional, URL association was enabled to occur specifically with audio information. See Column 3, Lines 30-35, Column 5, Lines 5-10. Thus, Portuesi disclosed the invention substantially as claimed.

18. Portuesi did not disclose two important aspects of the presently claimed and disclosed invention. First, Portuesi did not specifically disclose the use of embedded audio signals which were recognizable to either the rendering machine or a human viewer to effect information retrieval. Second, Portuesi did not specifically disclose effecting information retrieval through the use of a predetermined identification number which corresponded to particular vendor products or services.

In regard to embedded audio signals, Portuesi did expressly disclose the encoding of URL information into the digital multimedia. See, inter alia, Column 9, Lines 5-8, and

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Figure 5, reference numeral 62. This resulted in a digital video signal (including audio) with embedded URL information, expressly disclosed as capable for digital storage on, inter alia, video disk(s). See, inter alia, Column 9, Lines 3-21. While Portuesi provided a single example for express encoding of the URL information into the multimedia file (Column 9, Lines 8-11), the language used was intentionally open-ended, suggesting other methods of information encoding as potentially used with the concept of invention. This would have motivated one of ordinary skill in the art at the time the invention was made to explore related teachings to find suitable means for embedding/encoding URL information into multimedia information.

In regard to information retrieval based on identification numbers which correspond to particular products or services, the natural extension of information relating to product(s) or service(s) being delivered to a requesting or unsolicited consumer in parallel with video and/or audio advertisements would have been obvious to one of ordinary skill in the art at the time of invention. This would have motivated one of ordinary skill in the art to explore product information retrieval techniques for this purpose; the linking of timely, relevant information corresponding to specific products or services during advertisements would have been recognized as desirable by one of ordinary skill in the art at the time of invention.

19. In the related art of television (video) and radio (audio) and the encoded use of audio controlling signals, Sherman disclosed the embedding of "substantially indiscernible" audio touch tones which effect functionality of a reception device and the use of these embedded tone(s) on recorded media. See, inter alia, Column 2, Lines 28-47, and Column 3, Lines 14-17. The audio enabled value embedding as disclosed by

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Sherman provided yet another type of information encoding for use in the Portuesi system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use encoding/embedding as described by Sherman in the encoding/embedding system described by Portuesi in order to encode strings of values in an audio/video presentation corresponding to URL network address(es) to correlate information with the currently rendered video/audio presentation. Since the audio tones were "substantially indiscernible", it is clear that the tones were "perceivable" as claimed.

20. In the related art of database information look-up, Hudetz disclosed the correlation of identification numbers with particular products and vendor information/offers concerning these product(s) using a network of remote database(s). See, inter alia, Column 3, Lines 17-24. It is also noted that Hudetz specifically disclosed two important details: (1) the encoded identification number(s) were in "human and/or machine readable form" (Column 3, Lines 27-28), and (2) an identification number was input which resulted in retrieval of an actual or logical network address (routing information, as claimed) through use of a [usually, remotely] located database for number to address look-up (Column 3, Lines 25-37). In regard to the latter, in light of these cited portions of the Hudetz teachings, the provision for UPC barcode operation for input of identification number(s) did not preclude the use of other types of input device(s), methods, human or machine actuated input, or specific type(s) of alphanumeric string(s) which resulted in arbitrary identification number(s) to physical or logical network address mapping. See Column 3, Lines 25-37. That is, the use of UPC numeric codes scanned by a peripheral reading device was only one way to achieve the invention as described; a

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numerical value corresponding to the designated information for database lookup was the crux of the invention as disclosed.

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Portuesi and Sherman providing embedded information within multimedia presentations with the numerical to network address correlation provided by Hudetz, for example, in order to minimize the amount of information added to any given stored or compiled multimedia presentation. Bandwidth conservation and digital storage space was widely recognized as an inherent concern in the computer arts, and minimizing the amount of encoded information in a given multimedia presentation would have been readily evident. The provision for a short string, (e.g., eight or ten numbers) which effects the same information transfer functionality as a much longer URL or product identification designation and network address would have been obvious to one of ordinary skill in the art at the time the invention was made. See, inter alia, Hudetz, Column 3, Lines 1-13, and Column 11, Lines 21-27.

22. This combination of teachings expressly disclosed each and every limitation of the claimed invention as set forth:

(claim 1, 6, 11, 12, 13, 15, 16)

1. *Recorded [digital] information on [digital media]*, was taught, inter alia, by Portuesi in Column 3, Lines 23-26, and was taught by Sherman in Column 3, Lines 14-16. Further, the media which storage takes place on was completely arbitrary and a wide variety of digital storage mediums would have been obvious to one of ordinary skill in the art at the time of invention.

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2. *Embedding a unique perceivable code in digital video information*, was taught, inter alia, by the combination of teachings found in Portuesi, Column 6, Lines 33-46, and Sherman, Column 3, Lines 7-36.
3. *Unique perceivable code is output during normal playback of the [video]*, was taught, inter alia, by Portuesi in Column 5, Lines 64-66, and Sherman, Column 3, Lines 14-17.
4. *Unique perceivable code [mapping to] vendor routing information*, was taught, inter alia, by the combination of teachings provided by Portuesi by related URL inclusion, and Hudetz, Column 3, Lines 15-37.
5. *Operating the disk [by rendering in information thereon] (reading the data and outputting the data on a display)*, was taught, inter alia, by Portuesi in Column 3, Lines 22-29, and Sherman, Column 3, Lines 14-17.
6. *Extracting the unique perceivable code during output at the user location*, was taught, inter alia, by Portuesi in Column 5, Lines 64-66, and Sherman, Column 3, Lines 14-17.
7. *Transmitting the unique perceivable code to an intermediate location on the network*, was taught by Hudetz in Column 3, Lines 15-24.
8. *Returning routing information to the user location used to access information from a vendor*, was taught by Hudetz, inter alia, in Figure 5.
(claim 2, 7, 17, 18, 19)
9. *Accessing a database of vendor routing information, database [correlating] the unique perceivable code to routing information for a vendor*, was taught by Hudetz in Figure 4.

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10. *[Using the unique perceivable code for] interconnecting the user [computer] with vendor information*, was taught by Hudetz in Figure 5.

(claim 4, 9)

11. *Routing information is a URL*, was taught by Hudetz in Column 3, Lines 25-37.

(claim 5, 10)

12. *Unique perceivable code is an audible tone*, was taught by Sherman in Column 3, Lines 7-36.

(claim 14)

13. *Playback is integrated with the user computer*, was taught by Portuesi in Column 2, Lines 50-52.

23. Since all the claimed limitations set forth in claims 1-2, 4-7, and 9-19, were expressly disclosed by the combination of teachings provided by Portuesi, Sherman, and Hudetz, claims 1-2, 4-7, and 9-19, are rejected.

Allowable subject matter

24. Claims 3 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and the currently raised issues in respect to 35 U.S.C. §112, are remedied.

Response to Arguments

25. The arguments presented by Applicant in the response, Paper #18, received on 5/12/2003, are not considered persuasive.

26. Applicant argues distinguishing the presently claimed invention through use of the word "perceivable". As detailed under 35 U.S.C. §112, second paragraph rejections,

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above, the breadth of the claims through the use of this word and the claimed invention as a whole, is rendering interpretation of the claims and any specific bounds of the claimed subject matter, unobtainable. The metes and bounds of the invention are not easily ascertained from the claims. Applicant arguments do not provide any further distinguishing discussion, or narrowing of the claimed subject matter. It is noted that the claimed subject matter was known in the art at the time of invention through the use of a well known URL as part of a television/radio broadcast, and the use of the URL to get information by the viewer from a nearby computer.

27. Applicant arguments are not substantive enough to warrant detailed discussion. The breadth of the claims and the breadth of the discussion by Applicant is hindering advancement of the claimed subject matter. Significant detail (for example, incorporation of claims 2 and 3 into independent claim(s) 1, 6, and 11) is suggested as a starting point, to overcome the issue(s) of breadth, similarity of the claimed invention and the prior art, and isolation of the feature(s) which Applicant considers to be the actual invention, not simply the prior art systems as were well known and widely implemented at the time of invention.

28. As a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Shepard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The

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conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 545 (CCPA 1977). The above rejections assume ordinary knowledge and well known functionality in the field of computer networking. Motivation for obtaining and incorporating related technologies, and resulting modification(s) of any/all disclosed subject matter in the above rejections would have been reasonable to one of ordinary skill in the art at the time the invention was made. Lastly, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), clearly states “any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, reconstruction is proper”. The above rejection relies on the ability of an ordinary artisan to directly infer parallel concepts in related computing networking realms. It is submitted that one of ordinary skill in the art at the time the invention was made would have been motivated by the general teachings in specific areas to explore these field(s) in greater detail, thereby resulting in the incorporation of enhanced technology and functionality, as evident in the combined, modified system resulting in the above rejection. Applicant is reminded one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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29. Lastly, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Zigmond et al. (U.S. Patent Number 6,400,407) disclosed the communication of logical addresses in a channel of a video signal.

2. Kanazawa et al. (U.S. Patent Number 6,580,870) disclosed the linking of information to multimedia presentation(s), such as DVD.

31. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Powell, can be reached at (703) 305-9703.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 746-7238	(After Final Communications only)
(703) 746-7239	(Official Communications)
(703) 746-7240	(for Official Status Inquiries, Draft Communications only)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900, or Customer Service for Technology Center 2100 at (703) 306-5631.

MARC THOMPSON
Marc D. Thompson
Patent Examiner
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